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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,366	08/22/2001	J. Fernando Bazan	15631-0004801US	1749
28008	7590	05/06/2004	EXAMINER	
DNAX RESEARCH, INC. LEGAL DEPARTMENT 901 CALIFORNIA AVENUE PALO ALTO, CA 94304			MERTZ, PREMA MARIA	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/935,366

Applicant(s)

BAZAN, J. FERNANDO

Examiner

Prema M Mertz

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☒ Applicant's reply has overcome the following rejection(s): the rejection under 35 USC 251.
4. ☒ Newly proposed or amended claim(s) 18-24 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 18-24.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Prema Mertz*  
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Primary Examiner  
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1. The amendment filed on 4/23/2004 proposes amendments that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required. Amendments to the claims may only be made as set forth in 37 CFR 1.173(b)(2), as follows:

Subject matter being added to a new claim requires rewriting and underlining of the entire new claim. 37 CFR 1.173(b)(2) and (d).

In the instant application, the amendments submitted on 4/23/2004 are non-compliant because all of the subject matter being added to the new claim 18 has not been underlined i.e. sub-parts "a)" and "b)" of claim 18 have not been underlined. It is requested that in response to this action, pursuant to 37 CFR 1.173(b)(2) and (d), Applicants submit a compliant amendment with proper underlining of the new claim 18.

2. Claim 23 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained for reasons of record set forth at page 4 of the previous Office action (3/25/04).

Claim 23, is rejected as improperly dependent on claim 18. For example, claim 23 recites " comprises the mature coding portion of SEQ ID NO:1 or 3", which limitation is broader than the limitations of independent claim 18. In column 15, lines 26-31 and column 16, lines 35-50, the instant specification discloses that fusion polypeptides between IL-B30s and other homologous or heterologous proteins encompass gene fusion partners including  $\beta$ -galactosidase,

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trpE, Protein A,  $\beta$ -lactamase, alpha amylase, alcohol dehydrogenase, yeast alpha mating factor, and detection or purification tags such as a FLAG sequence of His6 sequence. However, claim 18 recites "...polynucleotide encoding a polypeptide of SEQ ID NO:2" which encompasses only SEQ ID NO:2 and no other heterologous polypeptide as encompassed by dependant claim 23. Therefore, claim 23 is broader than independent claim 18. Furthermore, Applicants argue that with respect to claim 23, sub-part (a), since the signal sequence is about 21 amino acids, claim 23 is a smaller polynucleotide that encodes a polypeptide of SEQ ID NO:2 or 4 that lacks the signal sequence. However, contrary to Applicants arguments, claim 18 recites "...polynucleotide encoding a polypeptide of SEQ ID NO:2" which encompasses only SEQ ID NO:2 and not a smaller polypeptide. It is suggested that claim 23 be rewritten as an independent claim in order

to obviate this rejection.

3. Applicants are reminded for any supplemental amendment filed a concurrent oath or declaration is required.

**Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 271-0871.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Prema Mertz*  
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May 4, 2004